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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,591	01/03/2001	Jesse A. Jurrens		1866

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EXAMINER	
RODRIGUEZ, PAMELA	
ART UNIT	**PAPER NUMBER**
3683	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/753,591	JURRENS, JESSE A.	
	Examiner	Art Unit	
	Pam Rodriguez	3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 November 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 06, 2003 has now been acted upon.

Drawings

2. The proposed drawing correction submitting new Figure 6, filed on November 21st, 2001 has been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of Figure 6 and all the particulars of the swing arm structure as described in paragraph 3 below in the cited new matter passages. The substitute sheets for Figures 1-5 however have been entered. Therefore the previous drawing objection in paragraph 2 of the previous office action (paper no. 3) is repeated below.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the swing arm with its pairs of arms, wheel mounts, connectors, and upper, lower, and intermediate transverse

cross members must all be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

With regards to applicant's arguments with respect to newly submitted Figure 6 re-presented above, the examiner maintains her position. As suggested by applicant, the examiner has reviewed the text of applicant's previous patent as basis for the changes, however, the subject matter of that patent (6,003,628) is not relevant to the instant case, as applicant has not claimed any domestic priority to the document to link the application and it together. Therefore, the new matter problems remain in the case.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the two air bag suspension systems forming two parallel shock absorbers as claimed in Claims 4 and 29 must be shown or the feature(s) canceled from the claim(s). And also the details of the swing arm assembly described in paragraph b of Claim 6 is not illustrated (see the comments above regarding newly submitted Figure 6 which appears to disclose these details but has been deemed new matter). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The substitute specification filed November 21st, 2001 has not been entered because it does not conform to 37 CFR 1.125(b)because: it lacks a marked up copy and because it contains new matter as outlined below.

6. The amendment to the specification (substitute specification) filed November 21st, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The new matter is present in newly added paragraph 0041 on page 17, more specifically lines 16-18 and the phrase "Disposed...90", lines 20-21 of that same page and the phrase "extends.....90" is also new matter, and lines 22-25 of the same page and the phrase "by....84". New matter is also present in the entire paragraph 0042 which describes subject matter not previously disclosed.

Applicant is only permitted to describe what was in his original specification and drawings. These aforementioned passages describe new features not originally described in the specification and are therefore deemed new matter.

With regards to applicant's arguments with respect to the new matter objections to the substitute specification, the examiner maintains her position. As suggested by applicant, the examiner has reviewed the text of applicant's previous patent as basis for the changes, however, the subject matter of that patent (6,003,628) is not relevant to the instant case, as applicant has not claimed any domestic priority to the document to link the application and it together. Therefore, the new matter problems remain in the case.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 4 and 29 recite two air bag suspensions which are not disclosed in the specification. Claim 6 recites the details of the swing arm assembly, in particular, the wheel mounts, first and second arms, connectors, and cross members, which, with respect to the instant invention, have not been disclosed in the specification.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 4, 6, and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In portion "c." of Claim 4, the "at least two air bag suspension systems forming two parallel shock absorbers" are not disclosed anywhere in the specification.

In portion "b." of Claim 6, the details of the swing arm assembly, in particular, the wheel mounts, first and second arms, connectors, and cross members with respect to the instant invention have not been disclosed in the specification.

In Claim 29, the "pair of air bag suspensions" again is not disclosed anywhere in the specification.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 4, 7, and 17-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In portion "d." of Claim 4, the term "the shock absorber" is indefinite. It is unclear which of the plurality of shock absorbers previously claimed in portion "c." of the claim that applicant is referring to here.

Claims 7 and 18 contain the trademark/trade name Harley Davidson SOFTAIL. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a specific type of motorcycle suspension system and, accordingly, the identification/description is indefinite.

Claim 17 recites the limitation "the lower transverse cross member" in the second to last line of the claim. There is no antecedent basis for this limitation in the claim.

Claims 19-30 are rejected merely due to their dependency from Claim 17.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 6-12 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by ***U.S. PATENT NO. 6,003,628 TO JURRENS ET AL.***

Regarding Claim 6, Jurrens et al disclose a motorcycle comprising: a motorcycle main frame 14 having rear spaced-apart struts; a swing arm assembly 16, the swing arm including a pair of spaced apart wheel mounts 20 together carrying a rear wheel 24 therebetween, each of the wheel mounts 20 of the pair of wheel mounts having a first arm 26 and a second arm 28 extending from the wheel mount 20 and a connector 30 connecting the first arm 26 to the second arm 28 of the wheel mount, the connectors 30 joined to each other by upper and lower transverse cross members 32 and 34, and an intermediate cross member 38 extending between the connectors 30 and serving as a pivoting connection to the frame between the struts of the frame, wherein the connection to the frame pivots to allow the rear wheel 24 to pivot and move arcuately relative to the motorcycle main frame 14; a forward frame mount 78 on the main frame 14; a swing arm mount 106 on the lower connector of the swing arm 16, the swing arm mount 106 situated below the pivotable connection between the frame 14 and the swing arm 16; and, an air-bag suspension member 10 connected between the forward frame mount 78 on the frame and the swing arm mount 106 on the swing arm, the air-bag suspension member including a piston (see Figure 12 and the piston of the shock absorber 140), generally horizontally disposed and compressing the air-bag suspension member 10 when the rear wheel 24 rises and extending the air-bag suspension member when the rear wheel 24 drops (see column 7 lines 1-36).

Regarding Claim 7, Jurrens et al disclose that the motorcycle, exclusive of the air-bag suspension member, is a Harley Davidson SOFTAIL* motorcycle (see column 5 lines 35-58).

Regarding Claim 8, Jurrens et al disclose that the air-bag suspension member includes air.

Regarding Claim 9, Jurrens et al disclose that the air included in the air-bag suspension member is pressurized (see column 6 lines 13-31).

Regarding Claim 10, Jurrens et al disclose that the pressurized air in the air-bag suspension member 10 is adjustable (see column 6 lines 13-31).

Regarding Claim 11, Jurrens et al disclose that the adjustment of the adjustable pressurized air in the air-bag suspension member alters ride height of the motorcycle (see column 6 lines 59-62).

Regarding Claim 12, Jurrens et al inherently disclose that the air-bag suspension member is characterized by a support spring force which is a function of compression stroke.

Regarding Claim 31, see Figure 7.

Regarding Claim 32, see Claim 11.

Regarding Claim 33, see column 6 lines 13-31.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 3-5 and 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***U.S. PATENT NO. 6,003,628 TO JURRENS ET AL IN VIEW OF U. S. PATENT NO. 3,752,270 TO VALDESPINO***.

Regarding Claim 3, Jurrens et al disclose a suspension system for a motorcycle (see Figure 12) having most all the features of the instant invention including: a motorcycle main frame 14, a swing arm 16 pivotally mounted to the motorcycle main frame about a pivot axis 18, at least one air bag suspension system 10, the air bag suspension system forming a shock absorber which includes at least one air bag 54 constructed of an elastomeric material, the air bag is housed within a housing assembly 52' and is secured at one end to a piston (see Figure 12 and the piston of shock absorber 140) and at another end to an upper plate or end cap 116 of the housing assembly 52' (see Figure 12 and column 8 lines 48-57), and the shock absorber is attached at a forward end to a cross member plate 78 of the motorcycle main frame 14 and is pivotally attached at a rearward end to a lower transverse cross member 66 of the swing arm 16 (see Figure 7).

However, Jurrens et al do not disclose that the air bag is secured at one end to a piston located ***within the housing assembly***.

Valdespino is relied upon merely for his teachings of an air bag suspension system (see Figure 6) forming a shock absorber which includes at least one air bag 46, the air bag is housed within a housing assembly 41 and is secured at one end to a piston 50 located within the housing assembly and at an other end to an end cap 43 of the housing assembly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the air bag suspension system of Jurrens et al to include an air bag housed within a housing assembly that is secured at one end to a piston located within the housing assembly as taught by Valdespino as an alternate means of damping the motorcycle to simplify the overall air bag suspension design and to reduce the overall number of parts to the assembly. By constructing the air bag and shock absorber as one piece, a reduction in cost and simplicity of manufacture can be achieved.

Regarding Claim 4, see Claim 3 and note Figure 7 of Jurrens et al which discloses two air bag suspension systems.

Regarding Claim 5, see Claim 3 above and shock absorber 140 in Figure 12 of Jurrens et al.

Regarding Claim 17, Jurrens et al disclose most all the features of the instant invention including: an air-bag suspension 10 for replacement of a stock coil spring suspension in a soft tail type motorcycle characterized by a motorcycle main frame 14 with a cross member plate 78 and a swing arm 16, the swing arm 16 pivotably attached to the motorcycle frame 14 and having a transverse cross member 34, the stock coil spring suspension having a forward end attached to the cross member plate 78 and a rearward end pivotably attached to the transverse cross member 32/34 (see Figure 12), the air-bag suspension for replacement of a stock coil spring suspension comprising: at least one air-bag 54 constructed of elastomeric material, the air-bag 54 having a first end and a second end; a housing assembly 52' with an end cap 66, the housing assembly 52'enclosing the air-bag 54, and the first end of the air-bag 54 secured to a

piston (see Figure 12 and the piston of shock absorber 140) and the second end of the air-bag secured to the end cap 66 ; and, a shock absorber 140, the shock absorber 140 having a forward end and a rearward end, the shock absorber attached to the housing assembly 52' and the shock absorber 140 attachable at the forward end to the cross member plate 78 of a motorcycle main frame and pivotably attachable at the rearward end to the lower transverse cross member 34 of the swing arm (see Figures 1-12).

However, Jurrens et al do not disclose that the air bag is secured at one end to a piston located ***within the housing assembly***.

Valdespino is relied upon merely for his teachings of an air bag suspension system (see Figure 6) forming a shock absorber which includes at least one air bag 46, the air bag is housed within a housing assembly 41 and is secured at one end to a piston 50 located within the housing assembly and at an other end to an end cap 43 of the housing assembly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the air bag suspension system of Jurrens et al to include an air bag housed within a housing assembly that is secured at one end to a piston located within the housing assembly as taught by Valdespino as an alternate means of damping the motorcycle to simplify the overall air bag suspension design and to reduce the overall number of parts to the assembly. By constructing the air bag and shock absorber as one piece, a reduction in cost and simplicity of manufacture can be achieved.

Regarding Claim 18, see Claim 7 above. However, Jurrens et al., as modified, do not specifically disclose that the stock coil spring suspension is characterized by a spring force which is a linear function of shock stroke.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the air bag suspension member of Jurrens et al., as modified, so that the spring force is a linear function of shock stroke as a matter of design preference dependent upon the desired damping characteristics of the suspension system. As long as the spring force is related to the shock stroke to provide adequate damping to the air bag system, their relationship to one another is arbitrary.

Regarding Claim 19, Jurrens et al., as modified, disclose most all the features of the instant invention as applied above except for the specifics of the spring force being a progressive function of shock stroke.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the air bag suspension member of Jurrens et al., as modified, so that the support spring force is a progressive function of shock stroke as a matter of design preference dependent upon the desired damping characteristics of the suspension system. As long as the spring force is related to the shock stroke to provide adequate damping to the air bag system, their relationship to one another is arbitrary.

Regarding Claim 20, see Claim 8 above.

Regarding Claim 21, see Claim 9 above.

Regarding Claim 22, see Claim 10 above.

Regarding Claim 23, see Claim 11 above.

Regarding Claim 24, see Claim 12 above.

Regarding Claim 25, see Claim 13 below.

Regarding Claim 26, see Claim 14 below.

Regarding Claim 27, see Claim 15 below.

Regarding Claim 28, see Claim 16 below.

Regarding Claim 29, see Figure 7 of Jurrens et al.

Regarding Claim 30, see column 6 lines 13-31 of Jurrens et al.

16. Claims 13-16 and 34-37 rejected under 35 U.S.C. 103(a) as being unpatentable over ***U.S. PATENT NO. 6,003,628 TO JURRENS ET AL}***

Regarding Claims 13 and 14, Jurrens et al disclose most all the features of the instant invention as applied above except for the specifics of the support spring force being a progressive function of compression stroke or an exponential function of compression stroke.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the air bag suspension member of Jurrens et al so that the support spring force is either a progressive function or an exponential function of compression stroke as a matter of design preference dependent upon the desired damping characteristics of the suspension system. As long as the spring force is correlated to the compression stroke to provide adequate damping to the air bag system, their relationship to one another is arbitrary.

Regarding Claim 15, see column 6 lines 13-31.

Regarding Claim 16, see column 6 lines 13-31, where inherently this limitation would be true.

Regarding Claims 34-37, Jurrens et al disclose most all the features of the instant invention as applied above, except for the specifics of adjusting the air in the air bag suspension to a spring force from about 0 – 2800 lbs at about 0 inches to 1.5 inches shock stroke.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the air in the air bag suspension of Jurrens et al to a spring force ranging from 0 -2800 lbs at a range of 0 to 1.5 inches shock stroke as a matter of design preference dependent upon the desired damping characteristics of the suspension. As long as the spring force is adequate to adjust for any type of shock stroke, the specific spring force and corresponding amount of shock stroke is arbitrary.

Response to Arguments

17. Applicant's arguments filed October 22, 2003 and November 6, 2003 have been fully considered but they are not persuasive.

With regards to applicant's arguments with respect to the new matter objections to both the substitute specification and the newly submitted Figure 6 re-presented above, the examiner maintains her position. As suggested by applicant, the examiner has reviewed the text of applicant's previous patent as basis for these changes, however, the subject matter of that patent (U.S. Patent No. 6,003,628) is not relevant to the instant case, as applicant has not claimed any domestic priority to the document to

link the application and it together. Therefore, the new matter problems remain in the case.

And lastly, applicant does not clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

Therefore, it is for these reasons that the rejections have been made.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Nos. 6,193,005 and 6,905,126 both to Jurrens disclose air bag suspension systems similar to applicant's.

U.S. Patent No. 5,711,390 to Hikichi et al and U.S. Patent No. 6,357,546 to Crosby, Jr. both disclose motorcycle suspensions equipped with air bag components.

U. S. Patent No. 4,354,693 to Maeda et al and U.S. Patent No. 4568,101 to Bleustein et al disclose shock absorbers equipped with air bags.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pam Rodriguez whose telephone number is 571-272-7122. The examiner can normally be reached on Mondays 5:30 AM -4 PM and Tuesdays 5 AM -11 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 3683
10/16/05

Pr
10/16/05